

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q62634

Kazuaki KINJYOU

Appln. No.: 09/758,203

Group Art Unit: 2854

Confirmation No.: 8552

Examiner: Kevin D. WILLIAMS

Filed: January 12, 2001

For: RECORDING APPARATUS AND METHOD THEREOF AND REMOVING CLAW
THEREFOR

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated October 20, 2004. Entry of this
Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-7 are pending in this application, all of which stand finally rejected and are hereby appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

As set forth in the Appeal Brief filed on July 23, 2004, the following issues correspond to the grounds of rejection to be reviewed on appeal:

Whether claims 1-7 should stand rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's admitted prior art ("AAPA") in view of U.S. Patent No. 4,447,054 to Sone ("Sone").

ARGUMENT

Claims 1-7 are patentable over AAPA in view of Sone for the reasons set out in the Appeal Brief.

The Examiner's Answer does not explicitly set forth a new grounds of rejection, but does newly refer to Hanks (U.S. Pat. No. 6,293,545 [col. 2, lines 61-64]) in an attempt to disclose the "state of the art." This newly applied reference is cited in the Response to Argument section of the Examiner's Answer and is provided in an effort to supply motivation to modify AAPA and Sone (see, for example, page 5, line 10-page 6, line 11 of the Examiner's Answer).

It is noted that patents relied on to show the state of the art need to have an issue date earlier than the effective filing date of the application under consideration. See *In re Budnick*, 537 F.2d 535, 538, 190 USPQ 422, 424 (CCPA 1976). An analogous point was made in *In re Gunn* 537 F.2d 1123, 190 USPQ 402 (CCPA 1976), where the court indicated that patents issued after the filing date of the applicant's application are not evidence of subject matter known to any person skilled in the art since their subject matter may have been known only to the patentees and the Patent and Trademark Office. (See also MPEP §2106.02.)

Hanks was published on September 25, 2001, which is after the January 12, 2001 filing date of the present application and, therefore, the Examiner's reliance on this reference is respectfully submitted to be misplaced. As noted in the Appeal Brief filed on July 23, 2004, the present invention includes a novel and unobvious combination of elements that addresses problems in the prior art. Appellant respectfully submits that the attempted reliance on Hanks further emphasizes that lack of teaching in the prior art to provide the present invention and its beneficial features.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

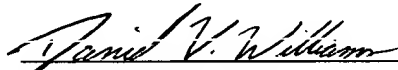
Respectfully submitted,

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